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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,560	01/27/2004	Hiroshi Akiyama	040022	9032

23850 7590 11/16/2005

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EXAMINER

ROBINSON, MARK A

ART UNIT PAPER NUMBER

2872

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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NOV 16 2005

In re Application of:
Hiroshi Akiyama et al.
Serial No.: 10/764,560
Filed: January 27, 2004
U.S. Patent No. 6,937,390
Issued: August 30, 2005
Attorney Docket No. 040022

DECISION RETURNING
PRIOR ART CITED UNDER
35 U.S.C. § 301

The prior art citation under 35 U.S.C. § 301 and 37 C.F.R. § 1.501, filed by the patent owner on October 28, 2005, is before the Group Director of Examining Group 2800 for consideration. The citation is being returned.

STATUTES, REGULATIONS AND PRACTICE

35 U.S.C. § 301 reads as follows:

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential. (Emphasis added.)

37 C.F.R. § 1.501 reads, in pertinent part:

(a) At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications

which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth under §§ 1.502 and 1.902. (Emphasis added.)

Section 2205 of the Manual for Patent Examining Procedure (M.P.E.P.) reads, in pertinent part:

The prior art which may be submitted under 35 U.S.C. 301 is limited to “written prior art consisting of patents or printed publications.”

An explanation is required of how the person submitting the prior art considers it to be pertinent and applicable to the patent, as well as an explanation of why it is believed that the prior art has a bearing on the patentability of any claim of the patent. Citations of prior art by patent owners may also include an explanation of how the claims of the patent differ from the prior art cited. . . .

A prior art citation is limited to the citation of patents and printed publications and an explanation of the pertinency and applicability of the patents and printed publications. This may include an explanation by the patent owner as to how the claims differ from the prior art. (Emphasis added.)

Section 2206, II, B states as follows:

B. Citation Filed by the Patent Owner

If an improper prior art citation under 37 CFR 1.501 is filed by the patent owner prior to an order for reexamination, it should not be entered in the file.

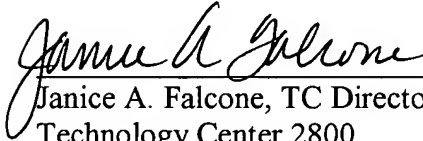
The patent owner should be notified of the nonentry, and the citation papers should be returned to the patent owner along with the notification. Prior art submission filed by the patent owner after an order for reexamination should be entered in the file under 37 CFR 1.555 (for ex parte reexamination) or under 37 CFR 1.933 (for inter partes reexamination)...

DECISION

The prior art citation lacks an explanation of the pertinency and the manner of applying the cited prior art to at least one claim of the patent as required. Accordingly, the citation of prior art filed October 28, 2005 does not meet the conditions for entry into the patent file. The citation is being returned.

This decision is made of record in the patent file.

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.



Janice A. Falcone, TC Director

Technology Center 2800

Semiconductors, Electrical and Optical
Systems and Components

Enclosure: Citation of prior art filed October 28, 2005